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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/942,700	08/31/2001	Mikio Nagasawa	H-1007	8877
7590 11/07/2005			EXAMINER	
MATTINGLY, STANGER & MALUR, P.C. ATTORNEYS AT LAW SUITE 370 1800 DIAGONAL ROAD ALEXANDRIA, VA 22314			SMITH, TRACI L	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 11/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/942,700

Applicant(s)

NAGASAWA, MIKIO

Examiner

Traci L. Smith

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to papers filed on August 23, 2005.
2. Claims 1-10 have been amend.
3. Claims 1-10 are pending.
4. Claims 1-10 are rejected.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification does not enable one skilled in the art to perform the following steps

Claim 1-Simulating estimated service performance: how does one simulate and what is used to simulate? What is an estimated performance and what information is used to get an estimate?

Claim 3-How does the average time get estimated? How is the maximum time determined? What information is used to estimate? What is the basis for the estimation?

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Claim 4-claim states re-calculation, there is no initial formula calculation let alone a second formula that would allow for one skilled in the art to know how to re-calculate or what to use in the calculations.

Claim 10 recites algorithms with not such explanation in the specification as well as an arithmetic process with no mathematical computations in the specification.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 5 732 400 Mandler, et al; System and Methods for Risk-based Purchase of

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goods. The examiner has applied the above reference to the claims as the examiner is best able to understand the claims.

11. As to claim 1 A method and apparatus for providing information services comprising a means for controlling brokering and booking resources for offering a service (the means will be referred to as brokering means hereinafter):

- a. intervening between resources for information processing services be offered by a plurality of providers of the resources *Mandler teaches process taking place with a broker acting between the buyer and seller.*(C. 4 l. 5-7)
- b. for information processing services and administrators operating information service systems including computer platforms (both the providers as service resource providers hereinafter) and users of said resources, *Mandler teaches buyers, sellers and a clearinghouse administer service transactions.*(C. 3 l. 33-34)
- c. said brokering means including resource performance holding credit data data for the resource comprising the steps of; providers, *Mandler teaches teaches the financial clearing house using credit data to establish risk.*(C. 3 l. 43-46).
- d. said brokering means receiving performance request specifications of resources for a user-desired service from the user; simulating estimated service performance of resources based on said request specifications and said credit data, thereby allocating one or more combinations of serviceable resources that satisfy, in the aggregate, said request specifications; *Mandler teaches receiving a*

request from user. And upon preliminary approval transmit requests to sellers for review.(C. 4 I.20-27).

e. issuing a resource reservation ticket to the user, the ticket including data that entitles the user to utilize said one or more combinations resources; *Mandler teaches issues a notice of the goods being shipped and an invoice so buyer can purchase service.(C. 4 I. 39-43)*

f. and placing an order with the resource providers for said one or more combinations of resources thereby booking the resources for the user. *Mandler teaches allowing the user the opportunity to purchase service(C. 4 I. 51-52).*

As to claim 2, means executes simulation of the performance of resources, based on the user's request specifications,

allocates the adequately-performing resources of one or more resource providers, according to the result of the simulation, determines what quantity of resources are necessary and sufficient for fulfilling said request specifications *Mandler supplies quotes in response to request(C. 7 I. 38-40).*

and time during which function and resources are required to run, *Mandler teaches a time frame for the transaction(C. 15. I. 27-28)*

issues resource reservation ticket, according to the allocation, *Mandler teaches giving the request a transaction ID associated with request for goods.(C. 7 I. 25-27).*

wherein the brokering means will issue the respective resource

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reservation tickets to plurality of service users (customers), *Mandler teaches providing quotes form multiple sellers for request.(C. 7 I. 40-42).*

moreover, after successfully reserving resources, brokering means sends the service performance request specifications, based on which the resources have been reserved, to the providers of the allocated resources, *Mandler teaches sending Purchase order to seller for the services requested.(C. 7 I. 55-57)*

and when resource providers determine their service resources required to execute the service in future, the brokering means compares available function and resources and required function and resources for a specific period and manages the thus obtained data decide whether the service providers can provide additional service performance resources. *Mandler teaches sellers selected by broker as meeting the performance specifications and ability to deliver goods. (C. 8 I. 41-44).*

12. As to claim 3 *Mandler teaches transaction ID with a ll information or messages associated with the service.(C. 7 I. 25-28).*

13. As to claim 4 *Mandler teaches negotiations between buyer and seller for meeting the requirements of the request.(C. 7 I. 55-58).*

14. As to claim 5 *Mandler teaches choosing a seller based on performance criteria and quality of goods.(C. 8 I. 41-44).*

15. As to claim 6, *Mandler teaches information used in determining both reliability of the buyer and the seller.(C 8 I. 34-40 & 48-50).*

16. As to claim 7 *Mandler teaches determining which resources meet the specification of the users request(C. 7 I. 35-37 & 39-41). As well as using credit data in the determination(C. 7 I. 30-31).*

17. As to claim 8 *Mander teaches editing the information from one form of data to another using an EDI translator(C. 10 I. 20-25). And electronically sending information(C. 7 I. 53-54). As well as a storage medium(Fig. 2 Ref 45).*

18. As to claim 10 An apparatus for authenticating an authorized service user comprising a means authorized service user authentication which authenticates that the user authorized to use service by verifying the validity of the user's resource reservation ticket issued to guarantee the right the service user and the performance resources to execute the service, *Mandler teaches receiving authorization and verification of risk and approval message user qualifies for services requested.*

19. a first storage means to store said resource reservation ticket data, a second storage means to store resource allocation information, *Mandler teaches multiple database used for storing different information.(Fig. 2 Ref. 45).* The examiner takes notice that even though the reference teaches the use of more than one database the fact that the applicant claims the data base for storing specific information this information is considered non-functional descriptive matter. It does not matter what the type of information is that is being stored. A database is going to store the data regardless of what the information is therefore the steps of storing would be performed the same way every time.

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20. a means for communication between said first storage means and second storage means, *Mandler teaches a communication network(Fig. 1B Ref. 5 and Co. 6 l. 22-23).*

21. and a means for verifying certificate data which executes predetermined arithmetic processing based on algorithm for encryption/decryption and other security purposes for the reservation data and resource allocation data and verifies the validity of the resource reservation. *Mandler teaches evaluation of credit risk based on a variety of factors.(C. 6 l. 54-56).*

Response to Arguments

22. Applicant's arguments filed August 23, 2005 have been fully considered but they are not persuasive. Examiner notes applicants amendments to claims 2 and 5 overcome the rejection under 35 USC 112 1st paragraph. Examiner further notes the withdrawal of rejections under 35 USC 101.

23. As to applicants arguments regarding rejections under 35 USC 112 1st paragraph examiner is not persuaded by applicants arguments that the disclosure teaches the items questions in the first office action. As to the question of "simulation estimated service performance" even with the amendment removing "estimated" the examiner maintains the disclosure lacks support for one to reproduce the steps. On pg 12 l. 6 of applicants arguments points to a portion of the specification that teaches "simulation" the examiner notes a "quantitative evaluation" is required, however the disclosure fails to teach what "quantitative" method is required. The "quantitative evaluation" eludes to

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a need for a calculation which is not present in the disclosure, therefore does not enable one to reproduce the steps of the method. The applicant further argues that the simulation "judges whether the provider satisfies the request". The disclosure fails to identify what is required or deemed necessary to qualify as "satisfying" a request. If a judgement is made this begs the question of are there parameters or is it a subjective limitation. The applicant further states simulation is accomplished by "required capacity". Again, this is a calculation that is not disclosed and does not enable one to reproduce the steps of the method.

24. As applicants arguments regarding claim 10 and the use of "algorithms" applicant statement that the amendments made to claim 10 are sufficient to enable one to perform the algorithms the examiner disagrees. Regardless of when an algorithm is determined it still needs to be taught in the disclosure so one can replicate the steps of the algorithm. Claim 10 is an apparatus that is programmed to perform a method it is necessary for one to know how to program the apparatus to perform the steps of the method. A predetermined algorithm is one that is programmed into the system running on the apparatus. An algorithm is a vague mathematical function that has limitless possibilities. The disclosure must teach what algorithm is being used to accomplish the end result.

25. As to applicants arguments regarding the claim rejections under 35 USC 102(b) the examiner maintains rejection as stated above and reasons below.

26. As to applicants argument that Mandler fails to teach "requesting specification of resources" emphasizing that "resources" are not taught by Mandler. The examiner notes

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the term resources as claim in the applicant is a broad term and when given it's broadest reasonable interpretation it can include financial resources and information. The same can be said for "resource performance" the performance of a financial product can be included in "resource performance"

27. As applicant argues the same limitation for claims 3-4 as noted above the same reasoning for the rejection is applied as well.

28. As to applicants arguments regarding claims 2-8 do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

Conclusion

29. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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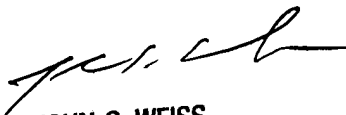
the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Traci L. Smith whose telephone number is 572-272-6809. The examiner can normally be reached on Monday-Thursday 6:00 am-4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TLS


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